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INVENTOR: Piechowski et al.

U.S. Serial N . 10/064,782

ELECTION WITH TRAVERSE

Applicant elects Group I, claims 1-6, with traverse, and requests reconsideration of the Restriction Requirement.

REMARKS

Claims 1-17 are pending in the present application. In the Office Action of January 14, 2003, the Examiner identified three groupings of the claims, Group I containing claims 1-6, Group II containing claims 7-12, and Group III containing claims 13-17.

The Examiner claims that Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship and states that "distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product" and cited MPEP §806.04(b). The Examiner is incorrect.

MPEP §806.04(b) deals with species or genus. Citing 37 CFR 1.141, §806.04(a) specifically states that "a reasonable number of species may still be claimed in one application if the other conditions of the rule are met." 37 CFR 1.141 states that "two or more independent and distinct inventions may not be claimed in one national application, *except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claimed species in excess of one are written in independent form or otherwise include all the limitations of the generic claim.*"

While Applicant does not concede that the Examiner applied the correct standard for restriction, it is clear that claim 1 is generic when compared to claim 7 of Group II in that claim 7 includes the gas filter as called for in claim 1.

Further, the Examiner is directed to MPEP §806.04(e) which states "claims are never species." The Examiner treated the claims as species, and therefore, the Restriction Requirement is fundamentally

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flawed. Based on these grounds, Applicant respectfully requests withdrawal of the Restriction Requirement.

Further, the Examiner did not follow the guidelines set forth in MPEP 806.04(b), which was cited by the Examiner. The first paragraph of this section states "where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP §806.05 — §806.05(i). If restriction is improper under either practice, it should not be required." The Examiner did not apply either of these standards. A review of the claims at issue would clearly indicate that they are not "distinct" under the meaning of §806.05. The Examiner claims that "the intermediate product is deemed to be useful as an air filter or gas separation filter *and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.*" However, it is the Examiner's obligation to find that the inventions are "distinct" not the Applicant's to show them to be obvious variants. Furthermore, the suggestion that the "intermediate product", apparently Group I, is useful as "an air filter or gas separation filter" is completely without merit. Claim 1 calls for "a gas filter" -- not an air filter. Furthermore, claim 1 calls for "the gas filter comprising a housing, the housing having an inlet adapted to be connected to a gas cylinder and an outlet adapted to be connected to a gas solenoid valve..." How this is anything other than a gas filter, is beyond the comprehension of the Applicant.

MPEP §806.04(h) is titled: "Species Must Be Patentably Distinct From Each Other". The Examiner is reminded that:

"In a national application containing claims directed to more than a *reasonable number of species*, the Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restrictions should not be required if the species claimed are considered clearly unpatentable over each other."

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Quite clearly, the Examiner's restriction of Groups I and II is not sustainable, and Applicant respectfully requests rejoinder of Groups I and II.

The Examiner next states Inventions I and III and Inventions II and III are related as product and process of use in paragraphs 3 and 4 of the Office Action, respectively. With regard to Inventions I and III, the Examiner states that the product can be used as an air filter in a furnace. Applicant knows of no furnace that would utilize a gas filter for an air filter. Let alone this basic conceptual dichotomy, the claim includes limitations that are specific to a gas filter, such as a housing having an inlet adapted to be connected to a gas cylinder and an outlet adapted to be connected to a gas solenoid valve. The housing is further defined as having a passageway extending between the inlet and the outlet and having a filter screen retained within the housing. The filter screen is defined as being located in the passageway to prevent articles exceeding a predetermined size from passing through the filter screen to reach the outlet. Claim 2 calls for threaded fittings on the inlet and the outlet. The suggestion that this product can be used as an air filter in a furnace is nonsensical.

Similarly, the Examiner states that Inventions II and III are related as product and process of use and states that the "product can be used as an air filter in an automobile." This allegation is even more puzzling. Claim 7 calls for a system for providing a shielding gas to a welding apparatus! The system includes "a cylinder containing a quantity of shielding gas, a gas hose having one end connected to the cylinder, a gas solenoid valve adapted to be opened and closed by means of an electrical signal, and a shielding gas filter. Applicant is completely confused as to how such a system could be used as an air filter in an automobile. Applicant wonders whether the Examiner and the Applicant are reviewing the same claims.

Since MPEP §806.05(h) states that "the burden is on the Examiner to provide an example" and although the example may not be documented, it quite simply must be a credible example. The examples provided by the Examiner are not credible. Accordingly, Applicant requests withdrawal of the Restriction Requirement based on these additional grounds.

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Additionally, the Examiner's classification of the Groups is inconsistent with the restriction. For example, the Examiner's classification of Group II, claims 7-12, "drawn to a welding apparatus with a shield gas supply" in class 219, subclass 121.33 is quite inconsistent with using this product as "an air filter in an automobile."

Additionally, the Examiner states that the "inventions are distinct for the reasons given above and having acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper." However, as previously stated, the Examiner has not met the burden to show that these inventions are distinct, and in addition, the Examiner has not shown a separate status in the art — the restriction is therefore actually improper. The Examiner classifies Group I, claims 1-6, in class 137, subclass 137+. However, this subclass is entitled: "Through Float-operated Vents" and is described as for apparatus in which the trapped air releasing means is actuated by a float responsive to accumulation of liquid in the siphon system. Reviewing the content of claim 1, and depending claims 2-6, Applicant can see no reason why the Examiner would classify this "invention" in this subclass. The Examiner next classifies Group II, claims 7-12 in class 219, subclass 121.33. This subclass definition is "subject matter wherein the particle beam generator structure is provided with means for receiving and utilizing a fluid as a working fluid in machining or as a cooling or shield fluid." While this subclass includes machines for welding, cutting, etc., Applicant does not understand how this class is relevant to claims 7-12. Group III however, claims 13-17, is classified in class 55, subclass 320+ which appears to be the only relevant subclass listed by the Examiner for the claims. This subclass is defined as "apparatus including an impingement or flow redirecting separator means together with a separator means of the type which retains therein or prevents passage therethrough as non-gaseous particles, the latter being comprised of massed entangled individual strands, massed individual discreet elements, numerous unentangled discreet strands (brush-type), or coherent sheet pores or foraminous material." The Examiner has not shown a separate status in the art for these alleged three inventions, and

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accordingly, the "inventions" should be rejoined and the Restriction Requirement withdrawn for yet this additional reason.

For all the above reasons, the Restriction Requirement is not sustainable and Applicant respectfully requests rejoinder of Groups I, II, and III. Should the Examiner disagree, Applicant respectfully requests a detailed explanation clarifying these incongruities so that the record is complete for review.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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Dated: February 14, 2003
Attorney Docket No.: ITW7510.016

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